

Application Number : 10/748,024  
Applicant : Alexander H. Little  
Filed : 30 December 2003  
T.C./A.U. : 2614  
Examiner : Monikang, George C.

Confirmation Number: 6524

Docket Number : APL-P3231  
Customer No. : 62096

### **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

Applicant respectfully requests a pre-appeal brief conference to review the rejection of independent claims 1, 10, 19, and 26 in the instant application under 35 U.S.C. § 102 as being anticipated by Fado et al. (U.S. patent no. 5,943,649, hereinafter “Fado”) and the rejection of independent claim 23 in the instant application under 35 U.S.C. § 103 as being obvious based on Fado in view of Applicant’s admitted prior art (hereinafter “AAPA”).

#### **I. STATUS OF APPLICATION**

In the Official Action mailed on **30 December 2009** (hereinafter “1230 OA”), the Examiner reviewed claims 1-33. Examiner rejected claims 1, 7-8, 10, 17-21, 26-29, 30-31, and 33 under 35 U.S.C. § 102(b) as being anticipated by Fado. Examiner rejected claims 11-12, 23-25, and 32 under 35 U.S.C. § 103(a) as being obvious based on Fado in view of AAPA.

#### **II. REMARKS AND ARGUMENTS**

Applicant respectfully disagrees with the above-described rejections. The rejection of independent claims 1, 10, 19, and 26 under 35 U.S.C. § 102(b) is

improper because Fado does not describe all of the claim limitations. Moreover, the rejection of independent claim 23 under 35 U.S.C. § 103(a) is improper because Examiner has failed to explain why the differences between Fado and AAPA and the claimed embodiments would have been obvious to one of ordinary skill in the art. Applicant's arguments are described in more detail in the following sections.

### **The Prior Art does not Describe All of the Claim Limitations**

As described in the Manual of Patent Examining Procedure (MPEP), in order to anticipate a claim under 35 U.S.C. § 102(b), each and every element as set forth in the claim must be found, either expressly or inherently described, in the prior art reference.<sup>1</sup> In the instant case, Examiner has failed to establish prima facie anticipation under 35 U.S.C. § 102(b) because Fado does not describe all of the claim limitations of independent claims 1, 10, 19, and 26 in the instant application. More specifically, although describing a user selecting a microphone from a list of microphones, Fado nowhere describes a self-identifying microphone that transmits data about itself through an I/O port.

In the Office Action Response filed on 14 October 2009 (hereinafter "1014 OAR"), Applicant analyzed the distinctions between Fado's system and the self-identifying microphone in the present invention. Applicant pointed out that in Fado, graphical user interface (GUI) 100 presents a list of possible microphones to a user and **the user selects one of the microphones** from the list.<sup>2</sup> Because Fado's computer system 1 executes the process described in FIG. 1 (and therefore provides GUI 100 to the user), the list of microphones is provided to the user by computer system 1 and *not by the microphone*.<sup>3</sup> Fado nowhere **describes a self-identifying microphone that transmits data about the microphone to an external device**

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<sup>1</sup> See MPEP § 2131

<sup>2</sup> See Fado, column 7, lines 33-37 and step 16 of FIG. 1

<sup>3</sup> See *id.*, FIG. 48, and column 15, lines 43-67

through at least one electrical contact. Please see pages 9-12 of the 1014 OAR for Applicant's complete argument.

In the Response to Arguments section in support of the rejection under 35 U.S.C. § 102 of the 1230 OA, Examiner clarifies his argument as follows:

the computer device determines if the microphone inserted matches the microphone type selected by the user (Fado et al. abstract). The circuit of the microphone that was inserted has to send information to the computing device in other for the computing device to determine if the microphone type matches with the microphone selected.<sup>4</sup>

However, although describing "testing" that involves determining if there is a valid audio signal from the microphone and generally configuring the computer system based on the audio properties of the microphone,<sup>5</sup> Fado nowhere describes a circuit in a microphone that sends information about the microphone to an external device.

Hence, the rejection of claims 1, 10, 19, and 26 under 35 U.S.C. § 102(b) based on Fado is improper because Fado nowhere discloses the claim limitations described by the Examiner. Applicant therefore respectfully requests the withdrawal of the rejection of these claims under 35 U.S.C. § 102(b).

**The Gap between the Prior Art and the Claimed Invention is so Great as to Render the Claims Nonobvious to One Reasonably Skilled in the Art**

When establishing prima facie obviousness when rejecting claims under 35 U.S.C. § 103(a), Examiner's cited prior art must cover the claimed subject matter.<sup>6</sup> Where the prior art does not cover the claimed subject matter, Examiner is required to explain the differences:

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<sup>4</sup> See 1230 OA, page 2

<sup>5</sup> See Fado, col. 11

<sup>6</sup> See MPEP § 2141(II)(A)

The prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, **Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.**

Moreover, the gap between the prior art and the claimed invention may not be so great as to render the claim nonobvious to one reasonably skilled in the art.<sup>7</sup>

In the 1230 OA, Examiner argued as follows:

“Claims 11-12, 23-25, & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable **over Fado et al, US Patent 5,943,649 as applied to claim 10** above, in view of applicants admitted prior art (AAPA, para 0003).”<sup>8</sup>

Applicant respectfully disagrees with the rejection. Examiner has failed to establish prima facie obviousness because Examiner has failed to explain fundamental differences between the cited Fado and AAPA prior arts and independent claim 23 in the instant application. Specifically, Examiner has failed to explain how Fado’s disclosure of the above-described graphical user interface (GUI) and AAPA’s disclosure of an external device render obvious the present invention’s self identifying microphone which includes a **circuit within the microphone** that **transmits data about the microphone** to an external device.

In the cited AAPA par. [0003] Applicant discloses an external device for increasing the audio fidelity of a microphone signal, which is fundamentally distinct from the self-identifying microphone of the present invention. Furthermore, the Fado system is limited to a **GUI** on a computer system which provides a list of microphones for a **user** to choose from. Neither Fado nor AAPA disclose a **circuit within a microphone** which **transmits data about the microphone** to an interface unit.

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<sup>7</sup> See MPEP § 2141(III)

<sup>8</sup> See 1230 OA, page 8, emphasis added

Hence, Applicant avers that the rejection of claim 23 under 35 U.S.C. § 103(a) using Fado and AAPA is improper because the cited references do not render obvious the claim limitations described by the Examiner. Applicant therefore respectfully requests the withdrawal of the rejection of these claims under 35 U.S.C. § 103(a).

### **CONCLUSION**

It is submitted that the present application is presently in form for allowance. Such action is respectfully requested.

Respectfully submitted,

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